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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/690,667 10/17/00 MACWILLIAMS

S 224.013US1

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QM12/0813

EXAMINER

CARTER, M	ART UNIT	PAPER NUMBER
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3722
DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 18, 24, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3, 18 and 24, it is not clear how a gap (absence of material) can comprise perforations.

In claim 32, line 6, "each gap" lacks proper antecedent basis, since only "a gap" has been claimed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 11, 15-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Fabel (5,836,622).

Fabel discloses a substrate having a first layer (12) having a first surface adapted to be printed (7) on and a second surface; a second layer (14) proximate the second surface of the first layer, the second layer comprising a first section and a second section having a gap (22) therebetween comprising a discontinuity in the second layer, the gap defining

a fold-line section (18) in the first layer when a folding force is applied to the substrate, the second layer covering substantially all of the second surface of the first layer except for the fold-line section (fig. 4), and the second layer having an adhesive (19) on a surface.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-10, 12-14, 20-29, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabel.

Regarding claims 6 and 20, Fabel discloses the claimed invention except for the fold-line section being offset from the centerline of the first layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the fold-line section at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding claim 8, Fabel discloses the claimed invention except for the second layer having a thickness preventing the second layer from bending when a folding pressure is applied. It would have been an obvious matter of design choice to provide any desired thickness of the second layer depending on the desired result, since such a modification would have involved a mere change in the size of a component. A change in size is

Art Unit: 3722

generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) .

Regarding claims 7 and 21, Fabel discloses the claimed invention except for the second layer having at least two gaps. It would have been obvious to one having ordinary skill in the art at the time the invention was made to any number of gaps in the second layer, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 9, 12-14, 23 and 29, Fabel discloses the claimed invention except for the second layer having a material which is darker than the first layer and the second layer being security label material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of material having certain desired characteristics, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 10 and 22, Fabel discloses the claimed invention except for the gap being discernible through the first layer. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the first layer with a material that would enable the user to view the gap through the layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 26, it is well-known in the art of printed matter to provide backing members (release liners) to the back of an adhesive layer to protect the adhesive during storage and shipping.

7. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabel in view of Cunningham (2,893,144).

Fabel discloses the claimed invention except for the method of applying the substrate to an edge of a stock member.

Cunningham discloses index tabs wherein first and second portions are folded over a paper sheet such that the first and second portions are on opposite sides of the sheet (figs. 1 and 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Fabel's invention to provide the substrate folded over a paper stock, as taught by Cunningham, for tabbing and indexing of sheets.

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Makowka (5,077,001) discloses a tamper-evident sealing system, Cole (5,236,766) discloses a file folder edge reinforcement, Ong (5,503,487) discloses custom index tabs, Whipp (5,792,536) discloses a multiple-layer label, Carlson (5,842,722) discloses printable laminates, Edwards (5,895,075) discloses a security label, and Fabel (6,257,624) discloses a postal form assembly.

Art Unit: 3722

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


mc
August 9, 2001


HENRY TSAI
PRIMARY EXAMINER